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Application No. 09/858,859
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REMARKS

Claims 15-29 are pending in the application. Claim 15 has been amended.

In the march 9, 2006, Office Action, claims 15-29 are rejected under 35 U.S.C. 102(b) as anticipated by Lee (U.S. Patent 4,053,433 as evidenced by Ravkin *et al.* (U.S. 2003/0008323 A1). The specific grounds for rejection, and applicants' response thereto, are set forth in detail below.

Support for amendments

The amendments to claim 15 is supported throughout the specification and specifically at page 14, lines 3-8, page 16, lines 12-13, and at page 26, lines 29 and 30 of the specification. These amendments add a recitation from the claim preamble into the body of the claim and make explicit that which was implicit, namely that the carriers are intended to be used as, and therefore must be chemically suitable for use as, solid supports for compound synthesis. Accordingly, the claim amendments require no new search and place the claims in condition for allowance and entry of the amendments respectfully is requested.

Rejections Under 35 U.S.C. §102

Claims 15-29 are rejected under 35 U.S.C. 102(b) as anticipated by Lee (U.S. Patent 4,053,433 as evidenced by Ravkin *et al.* (U.S. 2003/0008323 A1). Applicants respectfully traverse.

The Examiner states that the claim recitations regarding the use of the carriers for compound synthesis are merely a statement of intended use and carry no patentable weight. Applicants respectfully disagree. The explicit terms of the claim require that a carrier be suitable for use in a series of synthetic steps and this limitation necessarily implies certain structural attributes in the carrier. For example, the carrier must be chemically suitable for coupling a compound precursor to the carrier, and must also be compatible with, and stable to, a series of synthesis steps, all while retaining the code that identifies the carrier.

The Examiner further asserts that, although Lee does not describe the use of the "taggant" particles, those particles inherently have the property of being suitable for compound synthesis as that term is used in the instant invention. Ravkin is cited as showing that Lee's taggant particles may be used for compound synthesis. Applicants once again respectfully disagree.

Nothing in Lee describes that the taggant particles are suitable for coupling of compound precursors to the particles, nor that the particles are able to withstand multiple chemical synthesis steps while retaining the color-coding present on the particles. The Examiner asserts that Ravkin teaches this property of the Lee particles, citing the description at the beginning of paragraph 0116 of Ravkin for this proposition.

Applicants respectfully submit, however, that Ravkin merely describes attaching the taggant particles to pre-prepared library compounds and neither explicitly nor implicitly describes, teaches or suggests synthesizing compounds directly on the taggant particles. Lee or Ravkin neither describe how the taggant particles might be used for multi-step chemical synthesis, nor provide any details that would permit the skilled artisan to understand that the taggants could be used for this purpose. To this end it is notable that Example 1 of Ravkin describes (with no experimental detail) that *pre-synthesized* oligonucleotides were attached to taggant particles and states that the purported experiments show that "DNA can be linked to taggant carriers." This further demonstrates that Ravkin is merely using taggant particles of the type described by Lee as labels for pre-synthesized molecules, rather than using the particles as bases for multi-step syntheses.

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). MPEP 2112. Applicants respectfully submit that the Examiner has failed to show that the taggant particles described by Lee necessarily have the properties recited in the instant claims and therefore respectfully request that the rejection be withdrawn.

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CONCLUSION

In view of the foregoing amendments and remarks, applicants respectfully submit the claims are in condition for allowance. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact the undersigned to expedite prosecution of the application.

The Commissioner is hereby authorized by this paper to charge any fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 50-3840. **This paragraph is intended to be a CONSTRUCTIVE PETITION FOR EXTENSION OF TIME in accordance with 37 C.F.R. § 1.136(a)(3).**

Respectfully submitted,


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